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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,701	01/12/2001	Gary George	10003542-1	2736

7590 06/04/2004
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

COULTER, KENNETH R

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 06/04/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Handwritten signature

Office Action Summary

Application No.

09/759,701

Applicant(s)

GEORGE ET AL.

Examiner

Kenneth R Coulter

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-20 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1 – 8, and 10 - 20 are rejected under 35 U.S.C. 102(e) as being disclosed by Herz (U.S. Pat. No. 6,460,036) (System and Method for Providing Customized Electronic Newspapers and Target Advertisements).

2.1 Regarding claim 1, Herz discloses a computer implemented method for customizing electronic communications to a customer, the method comprising:

storing a set of customer provided data in a first database, the customer provided data associated with a customer identification code and characterizing the customer

(col. 31, line 62 – col. 32, line 6 “A pseudonym is an **artifact** that allows a service provider to communicate with users and **build and accumulate records** of their preferences over time.”; col. 29, lines 23 – 28 “A user’s electronic mail address also **uniquely identifies the user** and the user’s network vendor ... The network vendors ... provide access **passwords** for their subscribers.”; col. 5, line 63 – col. 6, line 2 “database of partial user profiles”);

generating a set of customer behavioral data in response to a data selection made by the customer at an information database (col. 17, lines 30 – 44 “Such feedback is stored long-term in summarized form, as part of a database of user feedback information.”);

storing the customer behavioral data in the first database in association with the customer identification code (col. 31, line 62 – col. 32, line 6);

configuring a content database for storage of a plurality of product data sets (col. 31, line 62 – col. 32, line 6);

selecting at least one data set from the content database as a function of the customer provided and the customer behavioral data (Abstract; col. 17, lines 13 – 26; col. 31, line 62 – col. 32, line 12); and

sending to the customer via a communications network the at least one data set from the selecting step (Abstract; col. 17, lines 13 – 26; col. 31, line 62 – col. 32, line 12).

2.2 Per claim 2, Herz teaches the step of constructing a communications message from the at least one data set as a function of a message delivery date specified in the customer provided data (col. 64, lines 10 – 19 “Each received document is viewed as a target object whose profile includes such attributes as ... date sent, ..., date of the last document received from this sender ...”; col. 75, lines 39 - 55).

2.3 Regarding claim 3, Herz discloses that the customer provided data includes a data set from at least one of the group consisting of customer survey data (col. 28, line 3 “telephone surveys”), electronic commerce transactions (Fig. 16, item 1600 “network vendor”; col. 71, lines 24 - 55), product and service registration data, call center data (col. 28, line 3 “telephone surveys”), point of sale information (col. 71, lines 24 – 55), and demographic data (col. 6, line 1; col. 28, lines 8 – 9 “demographic characteristics”).

2.4 Per claim 4, Herz teaches that the customer behavioral data includes customer selections of electronic newsletter subscriptions (Abstract).

2.5 Regarding claim 5, Herz discloses the steps of:

capturing behavioral data from a customer review of the communications message (col. 17, lines 29 - 44); and

storing the captured data as customer behavioral data in the first database (col. 17, lines 29 - 44).

2.6 Per claim 6, Herz captures data that includes transmitting customer behavioral data via an electronic mail jumpstation arrangement to the first database (col. 61, lines 17 - 28).

2.7 Regarding claim 7, Herz discloses obtaining access by the customer of the first database such that customer review is limited to a set of predetermined data sets (col. 68, line 57 – col. 69, line 11).

2.8 Per claim 8, Herz teaches that selecting the at least one data set includes selecting the at least one data set as a function of a set of business rules defined by the vendor (col. 30, lines 1 - 26).

2.9 Per claims 10 – 20, the rejection of claims 1 – 8 (paragraphs 2.1 – 2.8 above) under 35 USC 102(e).

Allowable Subject Matter

3. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R Coulter whose telephone number is 703 305-8447. The examiner can normally be reached on 5 4 9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 703 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KENNETH R. COULTER
PRIMARY EXAMINER



krc